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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,850	07/22/2003	Felix Bator	F-673	1866

7590

09/26/2005

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EXAMINER

COSIMANO, EDWARD R

ART UNIT

PAPER NUMBER

3639

DATE MAILED: 09/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/626,850

Applicant(s)

BATOR ET AL.

Examiner

Edward R. Cosimano

Art Unit

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 September 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: none.
Claim(s) objected to: none.
Claim(s) rejected: 1-3 and 9-14.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Edward R. Cosimano
Primary Examiner
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1. Applicant's claim for the benefit of an earlier filing data under 35 U.S.C. § 119(e) and 35 U.S.C. § 120 is acknowledged.

2. The proposed drawing correction filed 30 September 2004 has been approved.

2.1 The corrected combined set of drawings containing figs. 3, 5 & 6 as filed July 22, 2003 and figs. 1, 2 & 4 September 30, 2004 is acceptable to the examiner.

3. The disclosure is objected to because of the following informalities:

A) applicant must update:

(1) the application data in:

(a) paragraph number 49 on page 16, "In accordance with ... U.S. Patent Application Serial No. 09/474,327 ... transaction from the customer's account on the micropayment system.";

with the current status of each of the referenced applications, e.g., --now abandoned--, or --now patent #?--, or --which is abandoned and now serial number #?--, etc.

Appropriate correction is required.

4. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.52, § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(b-f).

5. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time

the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

5.1 Claims 1-3 & 9-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Whitehouse (6,005,945) in view of Brasington et al (EP 0893787 or 5,923,406) as evidenced by either Shah et al (5,822,738 or 2003/0078893).

5.1.1 In regard to claims 1-3 & 9-14, Whitehouse ('945) discloses a computer implemented machine/process which under the control of an operating program performs the function of dispensing postage over a network, for example the internet. In this system, an user obtains a meter license from the Postal authority so that the user may print postage. When a customer at a remote computer system, e.g. a PC 104, desires to print a postage indicia on an item of mail, then the remote computer system being used by the customer would create a demand/request transaction for evidence of the payment of the required amount of postage. Where the transaction request would include at least:

- A) an account identifier that identifies a previously established account as an indication of the method of payment for the required postage;

- B) a source address identifier indicating where a mail piece is to be mailed from or the origin zipcode of the item of mail;

- C) a destination address identifier indicating where the mail piece is to be mailed to or the destination zipcode for the item of mail;

- D) authentication information for authenticating that the postage request is from an end user associated with the specified user account identifier;

- E) data concerning the package size and/or weight sufficient to determine an amount of postage required for the mail piece; and

- F) a customer password, that would identify the customer.

The generated transaction demand/request is then sent via a suitable communications network, e.g. the internet, from the remote computer system of the customer to a vendors' remote server or data center 102, where the vendor is separate from the Postal service 180. Once the data center has received the transaction request, the data center processes the transaction request by verifying that the transaction demand/request is authorized. And, if the transaction request/demand is verified, then the data center further process the transaction request by

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effecting payment for the requested amount of postage in an account that is maintained at the data center and has been identified within the transaction request. Next, the data center continues to process the transaction request by creating/generating a postage indicia as evidence of postage payment and then sending the generated postage indicia as evidence of postage payment to the customer at the remote computer system for printing on the item of mail. Where the postage indicia would generally include data representing the user account identifier, source address identifier, and destination address identifier in a correspondence to the data in the postage requests.

5.1.2 It is noted that the evidence of postage payment that is obtained by the customers of Whitehouse ('945) does not originate from a vendors account as would be understood by one of ordinary skill since the each customer maintains an account at the data center. However in the environment of dispensing postage, either Brasington et al ('787 or '406) discloses a computer implemented machine/process which under the control of an operating program stored in a memory performs the function of dispensing postage from an vendors' account. As can be seen in figs. 2-4, kiosk 1 of either Brasington et al ('787 or '406) includes processor 31, memory 35, modem 37, customer input devices 15,17, printer 39 and camera 13 as shown in fig. 2 which is in communication with postal authority 91 through data center 49 as shown in fig. 4. In operation the operator of kiosk 1, or a postage vendor, would purchases an amount of postage from postal authority 91 which is stored in the vendor's account in data center 49 or memory 35. The postage value stored in the vendor's account at data center 49 or memory 35 may then be vended to a customer at kiosk 1 either directly from data center 49 or from or memory 35 of kiosk 1. When a customer approaches kiosk 1 to obtain postage, the customer would insert a suitable method of payment and would have in image obtained using camera 13. Next, if the payment was accepted, the vendor's postage account data stored either in data center 49 or in memory 35 (fig. 2) would be used to create a postage indicia as evidence of postage payment, where the indicia would include at least:

- A) an transaction number 79 or piece count;
- B) an indication of postage 75;
- C) originating zipcode 73; and
- D) a cancellation mark shown as town circle 77 that includes date of issue.

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Finally, the postage indicia and image are combined, and then printer 39 would produce one or more personalized postage stamps for the user. Hence in the system of either Brasington et al ('787 or '406) the user does not need to obtain a postage metering license to obtain postage from the licensed vendor or operator of kiosk 1.

5.1.3 Since:

A) the combined operation of computer 104 and data center 102 of Whitehouse ('945) is functionally equivalent to the combined operation of kiosk 1 and data center 49 of either Brasington et al ('787 or '406); and

B) the operation of the postage metering system of either Brasington et al ('787 or '406) would provide a machine/process that would make it easier for an customer to obtain postage on a need to have basis with out requiring the customer to first obtain a postage metering license since only the vendor/operator of kiosk 1 that sells postage to customers needs be licensed by the Postal authority,

it would have been obvious to one of ordinary skill at the time the invention was made that the postage metering system of Whitehouse ('945) could be modified to sell postage directly to unlicensed customers without requiring each customer to obtain a postage metering license as taught by either Brasington et al ('787 or '406).

5.1.4 As further evidence that a single secure metering device (SMD) or accounting unit of a postage metering machine/process may be used by a number of different users connected to the network, see either:

A) fig. 8 of Shah et al ('738) which in 1998 discloses a single SMD 600 that provides postage metering functions to a number of computers connected to communications network 500; or

B) figs. 1-3 of Shah et al ('893) which in 1999 discloses a single SMD 126 provides postage metering functions to a number of computers connected to communications network 106.

6. Response to applicant's arguments.

6.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

6.2 As per the 35 U.S.C. § 103 rejection, since:

A) none of the instant claims recite a limitation that requires the request for postage to originate from either a PC; or more than one computer system; or more than one location, applicant's arguments regarding either (1) the differences between PC metering and the applied prior art; or (2) the location from which the request for postage originates; or (3) the request originating from more than one computer system; are directed to unclaimed distinctions and merits and hence applicant's arguments are non persuasive.

B) It is respectfully noted that:

(1) machine claims are limited to equivalent structures that would fairly perform the associated functions/acts that required by the positively recited limitations of the claimed invention;

whereas,

(2) process claims are not limited to a particular structure that would implement the functions/acts required by the positively recited limitations of the claimed invention;

and further,

(3) the positively recited limitations of the claimed invention must be interpreted for what these positively recited limitations would be fairly convey to one of ordinary skill at the time of the invention and be understood by one of ordinary skill at the time of the invention;

In this regard see:

(1) In re Wilder, 166 USPQ 545, at 548 (CCPA 1970) where the Court stated that "every limitation positively recited in a claim must given effect in order to determine what subject matter that claim defines.", and

(2) In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (The court held that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit. Rather, the "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the

art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification."); and

(3) In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999), The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach; and

(4) In re Prater, 56 CCPA 1381, 1395-96, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (1969). "We are not persuaded by any sound reason why, at any time before the patent is granted, an applicant should have limitations of the specification read into a claim where no express statement of the limitation is included in the claim."

With the above in mind, it can be seen that:

(1) in regard to process claims 1-3 & 9-13 and machine claim 14, there is no positively recited limitation of these claims that would be understood by one of ordinary skill at the time of the invention as conveying to one of ordinary skill at the time of the invention that (a) the recited functions/acts of the "vendor" would not be carried out by the recited "customer"; or (b) that the recited "vendor" must be different from the recited "customer", and hence as these terms would be understood by one of ordinary skill at the time of the invention the recited "vendor" and "customer" or the "user" could in fact be the same entity and, therefore, applicant's arguments regarding any differences between the customer and the vendor in regard to the teachings of either Shah et al (5,822,738 or 2003/0078893) or Whitehouse (6,005,945) as these teachings would be fairly taught by the applied prior art are directed to unclaimed distinctions and merits of the disclosed invention and therefore are non persuasive.

(2) in regard to process claims 1-3 & 9-13 and machine claim 14, there is no positively recited limitation of these claims that would be understood by one of ordinary skill at the time of the invention as conveying to one of ordinary skill at the time of the invention that the recited functions/acts of the "data center" and the "remote personal computer" would be limited to only machines that have a

particular appearance and not to any machine that as taught by the prior art would perform functions/acts associated with theses named machines, and, therefore, applicant's arguments regarding any differences between the "data center" and the "remote personal computer" in regard to the teachings of either Brasington et al (EP 0893787 or 5,923,406) as these teachings would be fairly taught by the applied prior art are directed to unclaimed distinctions and merits of the disclosed invention and therefore are non persuasive.

(3) in regard to process claims 1-3 & 9-13 and machine claim 14, there is no positively recited limitation of these claims that would be understood by one of ordinary skill at the time of the invention as conveying to one of ordinary skill at the time of the invention that the recited "remote personal computer" would be limited to only machines at the location of the "customer" or "user", and, therefore, applicant's arguments regarding any differences between the recited "remote personal computer" in regard to the teachings of either Brasington et al (EP 0893787 or 5,923,406) regarding the locations of the kiosks as these teachings would be fairly taught by the applied prior art are directed to unclaimed distinctions and merits of the disclosed invention and therefore are non persuasive.

C) as can be seen from section 5.1.2 of the Final Office action, Brasington et al (EP 0893787 or 5,923,406) was never used to teach the use of a PC, but were in fact used to convey the teachings of: (1) what one of ordinary skill at the time of the invention would understand to be the content of a postage indicia; and (2) an entity with a license to dispense postage could in fact sell postage to another entities, hence, applicant's arguments regarding the teachings of the applied prior art not set forth by the examiner in the Final Office action are non persuasive.

D) as set forth in section 5 of the final Office action, the examiner has set forth a modification of the prior art as follows:

(1) in regard to Whitehouse (6,005,945) this reference clearly discloses a computer implemented postage metering system that under the control of an operating program stored in the associated components of the postage metering

system performs the functions of permitting an user located at a remote personal computer to contact a remote data center via communications network, which contains at least one postage metering accounting system that has been licensed to dispense postage, in order for the user to obtain postage;

(2) in regard to either Brasington et al (EP 0893787 or 5,923,406) these references clearly disclose a computer implemented postage metering system that under the control of an operating program stored in the associated components of the postage metering system performs the functions of permitting one or more users located at one or more remote computerized kiosks, where each kiosk contains a postage metering accounting system that has been licensed to a vendor, to obtain postage from the licensed vendor and thereby providing the desirable benefit that as taught by either Brasington et al (EP 0893787 or 5,923,406) the user of the postage kiosk would not have to first obtain a postage metering license in order to obtain postage; and

(3) in regard to either Shah et al (5,822,738 or 2003/0078893) these references clearly disclose a computer implemented postage metering system that under the control of an operating program stored in the associated components of the postage metering system performs the functions of permitting one or more users located at one or more remote computerized system, to access via a network a single central postage metering accounting system that has been licensed to dispense postage, in order at the remote computer system to obtain postage from the central postage metering accounting system.

Since the function of the data center of Whitehouse (6,005,945) is functionally equivalent to the function of the single central postage metering accounting system of either Shah et al (5,822,738 or 2003/0078893) and either Shah et al (5,822,738 or 2003/0078893) or Brasington et al (EP 0893787 or 5,923,406) teach the desirable function of using a single accounting system of postage metering system to dispense postage to users that have not be licensed by the associated postal authority, one of ordinary skill at the time of the invention would be motivated to make the modification as set forth by the examiner because such a modification would not change the principle operation of the postage

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metering system of Whitehouse (6,005,945) in view of either Brasington et al (EP 0893787 or 5,923,406) as suggested by either Shah et al (5,822,738 or 2003/0078893), since the data center of Whitehouse (6,005,945) must have at least one license to dispensed postage to one or more users located at remote computers. Hence, applicant's arguments regarding the examiner's use of hind sight when combining the applied prior art are non persuasive.

E) it is noted that one of ordinary skill at the time of the invention would have recognized that the claimed invention can not operate as argued by applicant, since if the recited "vender" and "customer" were in fact not the same then the request for postage by the customer must include an identification of the "vendor" from which the requested value of postage is to be dispensed in order for the recited process and system to properly account for value of postage that has been requested to be dispensed from the data center.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (571) 272-6802. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (571) 272-6812. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-3600.

7.1 The fax phone number for **UNOFFICIAL/DRAFT FAXES** is (571) 273-6802.

7.2 The fax phone number for **OFFICIAL FAXES** is (571) 273-8300.

7.3 The fax phone number for **AFTER FINAL FAXES** is (571) 273-8300.

09/14/05


Edward R. Cosimano
Primary Examiner Unit 3639